

### REMARKS

Claims 1-4 and 6-14 are pending. No new matter has been added. For instance, the amendments made to claim 1 are supported by originally filed claim 5 as well as the present specification at page 13, lines 24-25 and page 14, lines 5-8. Claim 7 was amended to depend upon claim 1. Newly added claims 8 and 9 are supported by the present specification at page 14, lines 5-8. Lastly, newly added claims 10-14 are supported by claim 1 as filed. Thus, no new matter has been added.

In view of the following remarks, the Examiner is respectfully requested to withdraw all rejections and allow the currently pending claims.

#### Objection to Claim 3

The Examiner objects to claim 3 asserting that it is improper since it does not refer to other claims in the alternative only. Applicants traverse and submit that claim 3 depends upon "claim 1 or 2." Such a multiply dependent claim is perfectly acceptable. See MPEP § 608.01(n)(A) ("*Acceptable Multiple Dependent Claim Wording*"). Reconsideration and withdrawal of this objection are respectfully requested. Claim 3 must be treated on the merits.

#### Issue under 35 U.S.C. § 102(b)

The Examiner has rejected claims 1, 2, 4, 5, 6 and 7 under 35 U.S.C. § 102(b) as being anticipated by Garlick, Jr. et al., USP 5,695,746 (hereinafter referred to as Garlick '746) as evidenced by two [www.minerals.net](http://www.minerals.net) website links. Applicants respectfully traverse this rejection.

Applicants point out that independent claim 1 relates to a substance-supporting porous silica, wherein a porous silica supports a substance selected from the group consisting of menthols, volatile substances, thermal substances, plant polyphenols and organic colorants, and has a specific surface area of from 400 to 1500 m<sup>2</sup>/g, and wherein the pore of the porous silica forms a hexagonal structure. The limitation concerning specific surface area has been added from the specification and the limitation concerning hexagonal structure has been added from claim 5, now cancelled.

However, Garlick '746 fails to suggest or disclose this claimed subject matter. For

instance, Garlick '746 fails to suggest or disclose a porous silica such as the present invention having "a specific surface area of from 400 to 1500 m<sup>2</sup>/g, and wherein the pore of the porous silica forms a hexagonal structure." As supporting evidence for this assertion, Applicants draw the Examiner's attention to the Declaration under 37 CFR 1.132, attached hereto.

In the Declaration, the porous silicas of Garlick '746 has been replicated (see item 2. starting at page 3 of the Declaration). As explained under item 3. of the Declaration, the porous silica of an example of the present invention has a larger specific surface area than those of Garlick '746. Specifically, the inventive example has a specific surface area of 1020 m<sup>2</sup>/g as compared to either 704 m<sup>2</sup>/g (Syloid 63 of Garlick '746) or 297 m<sup>2</sup>/g (Syloid 244 of Garlick '746). Moreover, both Syloid 63 of Garlick '746 and Syloid 244 of Garlick '746 have non-hexagonal structures, whereas the present invention has hexagonal structure for the pores.

Therefore, there can exist no anticipation of the presently claimed subject matter based upon Garlick '746. Moreover, the Declaration proves that the claimed features are not inherently in the disclosure of Garlick '746.

For a rejection to constitute "anticipation," all material elements of a claim must be found in the cited art reference. *In re Marshall*, 577 F.2d 301, 198 U.S.P.Q. 344 (CCPA 1978). Further, A theory of inherency must be supported by facts and/or technical reasoning that reasonably support a determination that the allegedly inherent characteristic necessarily flows from the teachings of the prior art. *Ex parte Levy* 17 USPQ2d 1461 (BPAI 1990) (emphasis added). In order for prior art to anticipate a claimed compound on the ground it is inherently produced in a prior art process, the inherency must be certain. *Glaxo, Inc. v. Novopharm Ltd.*, (EDNC 1993) 830 F. Supp 871, 29 USPQ2d 1126; *Ex parte Cyba* (POBA 1966) 155 USPQ 756; *Ex parte McQueen* (POBA 1958) 123 USPQ 37. The fact that a prior art article may inherently have the characteristics of the claimed product is not sufficient. *Ex parte Skinner* (BPAI 1986) 2 USPQ2d 1788. Inherency must be a necessary result and not merely a possible result. *In re Oelrich* (CCPA 1981) 666 F2d 578, 212 USPQ 323; *Ex parte Keith et al.* (POBA 1966) 154 USPQ 320.

In view of the above, Applicants submit that the anticipation rejection is improper and must be withdrawn.

Issue under 35 U.S.C. § 103(a)

The Examiner has rejected claim 3 under 35 U.S.C. § 103(a) as being obvious over Garlick '746 and Hayes et al., USP 4,562,063 (hereinafter referred to as Hayes '063). Applicants respectfully traverse this rejection.

It has already been shown above that Garlick '746 fails to disclose, either explicitly or inherently, the limitations of claim 1 of the present invention. The secondary disclosure of Hayes '063 fails to cure any of the deficiencies of Garlick '746. Therefore, there can exist no *prima facie* case of obviousness with respect to claim 1. Since claim 3 depends both directly and indirectly upon claim 1, it is likewise patentable. The Examiner is therefore requested to withdraw this rejection.

In view of the above amendment, Applicants believe the pending application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Craig A. McRobbie, Reg. No. 42,874, at the telephone number below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated: February 26, 2009

Respectfully submitted,

By 

Craig A. McRobbie  
Registration No.: 42,874  
BIRCH, STEWART, KOLASCH & BIRCH, LLP  
8110 Gatehouse Road  
Suite 100 East  
P.O. Box 747  
Falls Church, Virginia 22040-0747  
(703) 205-8000  
Attorney for Applicant

Attachment: Declaration under 37 CFR 1.132